

## REMARKS

Claims 1-9, 11-23 are pending in the present application. Reconsideration of the present application is respectfully requested of the Examiner in view of the remarks set forth herein.

In the Office Action mailed April 19, 2006, claims 1-3, 5, 7, 9, 11, 15, 16, 18, 20, 21, and 23 were rejected under 35 USC 103(a) as being allegedly unpatentable over *Amin* et al. (US 5,995,830) in view of *Akhteruzzaman* et al. (US 6,584,316). The Examiner's rejections have been respectfully traversed.

As the Examiner well knows, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would

have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness.

With regard to claim 1 that stands rejected under 35 USC 103(a) over *Amin* in view of *Akhteruzzaman*, the Examiner acknowledges that *Amin* fails to disclose automatically routing the call to a voice mail system so that the calling party at a telephony device can leave a voice mail message for a mobile device user to which a connection has been dropped from the call in response to determining that the communication has been dropped. However, the Examiner argues that *Amin* discloses all the features of claim 1 except the call routing feature in the event of a dropped call by switching to a voice mail. In particular, the Examiner asserts that the items 122, 108, 126 in Figure 1, MSC, voice mail node, and HLR described by *Amin* collectively correspond to the claimed voice message processing circuitry. According to the Examiner, since *Amin* determines that the call is dropped and whether the user is connected to the voice mail node at column 2 lines 1-31, it discloses all the features of claim 1 except the call routing feature. The Examiner relies on *Akhteruzzaman* to teach automatically routing the call feature, in response to determining that the communication has been dropped by asserting that in column 8,

lines 5-25, *Akhteruzzaman* describes the routing the caller to the voice mail of the intended party to which the call could not be transferred.

Claim 1, among other things, calls for an apparatus that enables a telephony device of a party in communication with a mobile device to leave a voice mail for a mobile device user in the event that the communication with the mobile device is dropped during a call between said party and the mobile device user. The voice message processing circuitry automatically routes the call, in response to determining the communication has been dropped for said telephony device of said party, to a voice mail system associated with the dropped communication of said mobile device user so that said party can leave a voice mail message for said mobile device user to which a connection has been dropped from the call.

In the Office Action, the Examiner relies on *Akhteruzzaman* to describe automatically routing of the call in response to determining the communication has been dropped. The Applicants respectfully submit that the Examiner misinterpreted the disclosure of *Akhteruzzaman* and thus erred in rejecting claim 1. Moreover, *Akhteruzzaman* is completely silent with regard to this feature and fails to remedy the fundamental deficiencies of *Amin*.

The Examiner alleges that it would be obvious to combine routing of the caller for leaving a message to the wireline terminal which stays unconnected in response to the timed dropping of a call if it fails to transfer the call from a wireless terminal described by *Akhteruzzaman* with *Amin* that describes routing of the user of the still connected communication device for leaving a message to the dropped communication device to arrive at Applicant's claimed invention. In fact, as noted below, the disclosures of the *Amin* and *Akhteruzzaman* references are considerably different. While the message in *Amin* is left for the user of a communication device to which a connection has been dropped, *Akhteruzzaman*

teaches leaving a message for the wireline terminal to which a connection is not established. However, claim 1 calls for automatically routing the call to a voice mail system so that the calling party at a telephony device can leave a voice mail message for a mobile device user to which a connection has been dropped from the call in response to determining that the communication has been dropped. Accordingly, the rejection is flawed because the Examiner's obviousness assertion is not substantiated by the combination of *Amin* and *Akhteruzzaman*.

The *Amin* and *Akhteruzzaman* references were not intended to be modified or combined, in a manner, as suggested by the Examiner. *Amin* describes routing to a voice mail of the user of the dropped communications device so that the user of the still connected communication device can leave a message. *Akhteruzzaman* is concerned with a timed dropping of a call if unable to transfer it from a wireless terminal to the intended party at a wireline terminal and routing the caller at the wireless terminal to the voice mail of the intended party at the wireline terminal. See *Akhteruzzaman*, col. 8, lines 17-25. The routing described by *Akhteruzzaman* is not directed to a voice mail system of a dropped mobile device so that the party at a connected telephone device can leave a message for the mobile device user to which connection has been dropped, as set forth in independent claim 1. To the contrary, *Akhteruzzaman* describes routing the caller to the voice mail for the wireline terminal to which the call did not get transferred at all.

Moreover, if the proposed combination is obtained, it would still be unable to perform the claimed features of the present invention. Furthermore, if there is not motivation to combine found in the reference itself, the references can not render claim 1 obvious in a *prima facie* manner. Therefore, for at least this reason, Applicants respectfully request that the rejection of independent claim 1 and claims depending therefrom be withdrawn and claims be allowed.

Independent claim 7 and its dependent claim are also allowable over the combination of *Amin* and *Akhteruzzaman* because these references at least do not teach that the voice message processing circuitry automatically routes a telephony device of a party to leave a voice mail message for a mobile device user in response to routing the call upon determining that the communication to the mobile device has been dropped. Independent claim 15 and its dependent claims and Independent claim 20 and its dependent claims are also allowable for at least one or more of the reasons presented above.

Claims 4, 12, 17, and 22 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over *Amin* in view of *Akhteruzzaman*. The Applicants respectfully traverse the section 103 rejection of claims 4, 12, 17, and 22. It is submitted that the rejected claims are not rendered obvious to one of an ordinary skill in the art in a *prima facie* manner. To establish a *prima facie* case of obviousness to one of an ordinary skill in the art, the prior art reference (or references when combined) must teach or suggest all the claimed limitations. As set forth below, Applicants respectfully submit that the §103 rejections fail to establish a *prima facie* case of obviousness.

The Examiner recognizes that *Amin* fails to teach that the party communicates with the dropped mobile device user over t wireless network via a mobile telephone device. However, ‘Official Notice’ is taken by the Examiner, stating that a plurality of mobile telephone users communicate to each other within the same wireless network via the same MSC is old and well known to one skilled in the art. The Examiner is respectfully requested to cite a reference to show the missing claimed features, *i.e.*, provide a teaching for the claimed features absent from the *Amin* and *Akhteruzzaman* references, whether considered alone or in combination.

Claims 6, 14, and 19 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over *Amin* in view of *Akhteruzzaman*, as applied to claims 1, 7 and 15 above, and in further view of *Amin* (US 6418307, hereafter *Amin-8307*). The Applicants respectfully disagree.

The Examiner recognizes that *Amin* fails to teach that a signal is to be transmitted to the cell equipment and notifying that a message has been left. To provide a teaching for the features absent from *Amin*, the Examiner relies upon *Amin-8307*. Applicants respectfully submit that *Amin-8307* fails to remedy the aforementioned fundamental deficiencies of *Amin* and *Akhteruzzaman* as set forth in claim 6. In particular, the Examiner asserts that *Amin-8307*, on column 1 line 46-61, teaches a message center that sends a notification to the cellular phone subscriber. Instead, *Amin-8307* teaches that a messaging center 100 in a cellular network receives a voice mail notification. The messaging center 100 then forwards the notification to a mobile switching center (MSC), which in turn forwards the voice mail notification to a base station. The base station then forwards the voice mail notification to a cellular phone operated by a subscriber. The messaging center 100 communicates with the home location register to determine the location of the subscriber who is to receive the voice mail notification. The home location register maintains a record of the location of the subscriber. See col. 1, lines 46-51 of *Amin-8307*. The messaging center 100 through its interaction determines the correct mobile switching center 12 and forwards the message. The mobile switching center 12 then forwards the message to the cellular base station 13 to the subscriber, who has a cellular phone or other mobile device that can display the voice mail notification. See col. 1, lines 46-51 of *Amin-8307*.

Accordingly, *Amin-8307* teaches that it is the mobile switching center 12 that forwards the message to the cellular base station 13 for a cellular phone or other mobile device, not the

messaging center 100. However, in claim 6, when the communication associated with the call is dropped, the voice message processing circuitry causes a signal to be transmitted to the cell equipment. Thus, Applicants respectfully submit that *Amin-8307* fails to remedy the aforementioned fundamental deficiencies of *Amin* and *Akhteruzzaman* as set forth in claim 6. Therefore, Applicants respectfully submit that the present invention is not obvious over the *Amin*, *Akhteruzzaman* and *Amin-8307* references, considered either alone or in combination.

Claim 8 stands rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over *Amin* in view of *Akhteruzzaman*. The Applicants respectfully disagree and note that the Examiner acknowledges that *Amin* fails to teach a second MSC and a second wireless network but takes “Official Notice,” stating that two mobile telephone users communicating with each other while each user belongs to different cell and different MSC of different wireless network is old and well known to one skilled in the art. The Examiner is respectfully requested to cite a reference to provide a specific teaching or suggestion for each instance where Official Notice is taken as to the claimed features in claim 8.

For at least the aforementioned reasons, Applicants request that the Examiner's rejections of claim 8 under 35 U.S.C. 103(a) be withdrawn. Additionally, the other pending claims, to the extent they call for one or more of the above-noted missing features, are also allowable for these reasons.

In view of the aforementioned reasons, Applicants respectfully submit that all the pending claims are allowable. Accordingly, a Notice of Allowance is respectfully solicited. The Examiner is invited to contact the undersigned at (713) 934-4089 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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